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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,388

09/22/2005

Eiji Furukawa

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12/21/2009

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EXAMINER

LIU, XUE H

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

12/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,388	Applicant(s) FURUKAWA ET AL.	
	Examiner XUE LIU	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 20-23, 26-29 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 26-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/3/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1791

DETAILED ACTION

Response to Amendment

1. Amendment to claims filed 9/3/09 is acknowledged. Currently, claims 16, 20-23 and 26-29 are pending. Claims 1-15, 17-19, 24-25 and 30 have been cancelled. Claims 16, 20-23, 26-29 are currently amended. Claims 23, 26-29 are withdrawn from further consideration.

Drawings

2. Objection to the drawing in the previous office action is withdrawn in view of submission of replacement drawings.

Specification

3. Objection to the specification in the previous office action is withdrawn in view of amendment to the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 1791

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atake (English abstract and machine translation of JP11-099536) in view of Yoshida et al. (English abstract and drawings of JP2000-117786).

Regarding claim 16, Atake teaches a manufacturing method for an injection-molded and in-mold decorated article P, comprising: setting a decorating film S between a first mold element 25 and a second mold element 12 placed in opposition to each other so that a molding space is defined by the decorating film S and the first mold element 25, the molding space comprising a product molding space 3 and a resin-discharging-use molding space 41-46 which is formed adjacent to at least part of the product molding space 3, into which resin from the product molding space 3 flows; injecting resin through runner 36 and gate 37 into the product molding space 3, thereby filling the product molding space 3 with resin as it flows radially outward from the gate 37 and into the product molding space 3; discharging part of the molding resin from the product molding space 3 into the resin-discharging-use molding space 41-46 as the molding resin continues to flow radially outward from the gate 37; filling the product molding space 3 with resin until complete; solidifying the molding resin filled in the molding space while decorating a surface of the molding resin with the decorating film S, so that the injection-molded and in-mold decorated article P is manufactured (English abstract, figs. 1-5, paragraphs 1, 3-5, 9, 16, 25, 30, 32, 42-48, 53, 60-62 and 65 in the machine translation). Atake does not teach that the molding space further includes a resin-injection-use molding space, which is formed adjacent to at least part of the product molding space, with a gate portion through which molding resin is injected

Art Unit: 1791

from outside of the molding space, and injecting the molding resin through the gate portion into the resin-injection-use molding space, thereby filling the resin-injection-use molding space with the molding resin as it flows radially outward from the gate portion and into the product molding space. However, Yoshida et al. teach: an injection molding apparatus wherein a molding space includes a resin-injection-use molding space 31 which is formed adjacent to at least part of the product molding space 3, with an injection hole 14 through which resin is injected into the auxiliary space parts 31, through which the resin is, in turn, injected into the molding space part 3; injecting the molding resin 4 through the injection hole 14 into the auxiliary space parts 31, thereby filling the auxiliary space parts 31 with resin as it flows radially outward from the injection hole 14 and into the molding space part 3 (English abstract, figs. 1-3 and 6-7). It would have been obvious to one of ordinary skill in the art to incorporate the teaching of Yoshida et al. in the injection molding process of Atake since Yoshida et al. teach that the use of a resin-injection-use molding space realizes a simple and precise molding and enables the productivity to be increased (English abstract).

Regarding claim 20, Atake teaches that the injection of the of the molding resin is performed in a state that, with the decorating film S placed between the first mold element 25 and the second mold element 12, the first mold element 25 and second mold element 12 are clamped to make the molding space hermetically closed (figs. 3 & 5, and paragraphs 3 and 16 in the machine translation).

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atake in view of Yoshida et al. as applied to claim 20 above, and further in view of Gumery et al. (Derwent abstract of FR2729886).

Art Unit: 1791

Regarding claim 21, Atake does not teach compressing the molding resin in the molding space by reducing the capacity of the molding space, after filling the molding space with the molding resin. However, Gumery et al. teaches an in mold paint coating of plastic parts wherein injecting the coating substance between the two cavity walls 12a, 13a is followed by adjusting the space between the cavity walls to give the required thickness of coating 16 in at least parts of the mold and adjusting the wall separation to a reduced value at the edge of the part so giving reduced coating thickness to prevent edge burrs forming (see Derwent abstract). It would have been obvious to one of ordinary skills in the art at the time of the invention to provide the teaching of Gumery et al. in the process of Atake since Gumery et al. teaches that reducing the capacity of the molding space after filling the molding space with molding resin prevents forming of burrs.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atake in view of Yoshida et al. as applied to claim 16 above, and further in view of Hashimoto (Partial English translation of JP-U-H04-71216).

Regarding claim 22, Atake does not teach that the injecting of the molding resin is performed when the decorating film is set between the first mold element and the second mold element, placed in opposition to each other in a condition such that the molding space is opened, and subsequently clamping the first mold element and the second mold element, thereby compressing the molding resin in the molding space by reducing the capacity of the molding space. However, Hashimoto teaches a molding process wherein the injecting of the molding resin 16a is performed when the surface skin member 13 is set between the first mold element 1 and the second mold element 2, placed in opposition to each other in a condition such that the

Art Unit: 1791

molding space is opened, and subsequently clamping the first mold element 1 and the second mold element 2, thereby compressing the molding resin 16 in the molding space by reducing the capacity of the molding space (see figs. 4-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the teaching of Hashimoto in the process of Atake in order to reduce a variation of the thickness of the coating and thus prevent burr formation since the coating will be evenly distributed in the molding space as a result of compression of the resin by the mold element.

Response to Arguments

9. Applicant's arguments with respect to claims 16 and 22 have been considered but are moot in view of the new ground(s) of rejection.

10. Regarding claim 21, applicant argues that Gumery does not disclose reducing the capacity of the molding space after filling the molding space with molding resin. However, Gumery teaches that coating 16 is injected into the molding space defined by two cavity walls 12a, 13a, adjusting the space between the cavity walls to give the required thickness of coating 16 in at least part of the mold; and adjusting the wall separation to a reduced value at the edge of the part so giving reduced coating thickness to prevent edge burrs forming (see Derwent abstract and figs. 4-6).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1791

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 6/3/09 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1791

Any inquiry concerning this communication or earlier communications from the examiner should be directed to XUE LIU whose telephone number is (571)270-5522. The examiner can normally be reached on Monday to Friday 9:30 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna Wyrozebski can be reached on (571)272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yogendra N Gupta/
Supervisory Patent Examiner, Art Unit 1791

/X. L./
Examiner, Art Unit 1791